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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/955,373	10/21/97	MOURITSEN	S P58774US3

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EXAMINER

SCHWADRON, R

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 10/30/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/955,373

Applicant(s)
Mouritsen et al.

Examiner
Ron Schwadron, Ph.D.

Group Art Unit
1644



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 13-27 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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15. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Supervisory Patent Examiner Christina Chan, at 703-308-3973. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

16. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 13-15 are drawn to a method of preparing a recombinant modified self protein, classified in Class 435, subclass 69.1.

II. Claims 16,17,27 are drawn to a composition comprising a modified self-protein or the modified self protein, classified in Class 424, subclass 184.1 and Class 530, subclass 350.

III. Claims 18-21 are drawn to a composition comprising cytokine conjugates, classified in Class 424, subclass 192.1

IV. Claim 23 is drawn to a method of treating allergy, classified in Class 424, subclass 810.

V. Claims 22,24,25 are drawn to methods of treating chronic inflammatory disease, classified in Class 514, subclass 885.

VI. Claim 26 is drawn to a method of inducing an antibody response against a self-protein classified in Class 436, subclass 547.

17. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the claimed product can be made by chemical synthesis using art known methods of peptide synthesis.

18. Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the claimed product can be made by chemical synthesis using art known methods of peptide synthesis.

19. Inventions II and IV/V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as an immunogen for the production of antibodies.

20. Inventions II and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as an immunogen to stimulate T cells which respond to said modified protein.

21. Inventions I and II are different products. These products are structurally and functionally distinct and have different uses. The cytokine conjugate composition contains a cytokine not found in the modified self protein composition. Therefore they are novel and unobvious in view of each other and are patentably distinct.

22. Inventions IV-VI are different methods. These inventions require different ingredients and process steps to achieve different goals. Invention IV is drawn to a method of treating allergy, while invention V is drawn to methods of treating chronic inflammatory disease, while invention VI is drawn to a method of inducing an antibody response against a self-protein. Therefore they are novel and unobvious in view of each other and are patentably distinct.


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23. Because these inventions are distinct for the reasons given above and the search required for any group from Groups I-VI is not required for any other group from Groups I-VI and Groups I-VI have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

24. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

25. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

26. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Dr. Ron Schwadron whose telephone number is (703) 308-4680. The examiner can normally be reached Tuesday through Friday from 8:30 to 6:00. The examiner can also be reached on alternative Mondays. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ms Christina Chan can be reached on (703) 308-3974. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.


RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1800 1600

Ron Schwadron, Ph.D.

Primary Examiner

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September 15, 1998



RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

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